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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/783,412

02/14/2001

Danny Soroker

6727/01290

4685

7590

01/07/2005

S. Peter Ludwig
Darby & Darby P.C.
805 Third Avenue
New York, NY 10022

EXAMINER

BAYARD, DJENANE M

ART UNIT

PAPER NUMBER

2141

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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0050103

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The Office Action mailed on 7/23/04 was unable to reach applicant's representative and was returned to the USPTO as undelivered. A request was made by the Applicant's representative to restart the response period.

Office Action Summary	Application No.	Applicant(s)	
	09/783,412	SOROKER ET AL.	
	Examiner	Art Unit	
	Djenane M Bayard	2141	

-- The MAILING DATE of this communication appears on the front sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |



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7590 07/23/2004
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Darby & Darby P.C.
805 Third Avenue
New York, NY 10022

EXAMINER

BAYARD, DIENANE M

ART UNIT PAPER NUMBER


2141

DATE MAILED: 07/23/2004

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8

Office Action Summary	Applicati n No. 09/783,412	Applicant(s) SOROKER ET AL.	
	Examiner Djenane M Bayard	Art Unit 2141	

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Period for Reply

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- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
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| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1-4 and 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,628,306 to Marchionda.
 - a. As per claims 1 and 14, Marchionda teaches a method for processing an electronic mail (e-mail) message having an attachment, comprising: receiving as input from a sender the e-mail message and the attachment, for transmission across a network (See col. 3, lines 40-41); receiving as input from the sender a designation of a first set of one or more recipients and a designation of a second set of one or more recipients (See col. 1, lines 47-53); sending the e-mail message and the attachment to the first set of one or more recipients (See col. 4, lines 63-67); and sending the e-mail message without the attachment to the second set of one or more recipients (See col. 5, lines 1-5).
 - b. As per claims 2 and 15, Marchionda teaches the claimed invention as described above. Furthermore, Marchionda teaches wherein receiving the designation of the first

Art Unit: 2141

set comprises extracting respective addresses of the one or more recipients in the first set from a field of the e-mail message indicative of primary recipients (See col. 4, lines 63-67), and wherein receiving the designation of the second set comprises extracting respective addresses of the one or more recipients in the second set from a field of the e-mail message indicative of secondary recipients (See col. 5, lines 1-5).

c. As per claims 3 and 16, Marchionda teaches wherein receiving the designations comprises: displaying a list of all recipients of the e-mail message and receiving from the sender respective designations with respect to at least some of the displayed recipients, which differentiate between those recipients who are to be placed in the first set and those recipients who are to be placed in the second set (See col. 6, lines 15-25);

d. As per claims 4 and 17, Marchionda teaches displaying a first visual representation, indicating that the one or more recipients in the first set were sent the e-mail message and the attachment; and displaying a second visual representation, different from the first representation, indicating that the one or more recipients in the second set were sent the e-mail message without the attachment (See col. 6, lines 42-55).

3. Claim 8-13 and 18-23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,327,612 to Watanabe.

Art Unit: 2141

a. As per claim 8, Watanabe teaches for processing an electronic mail (e-mail) message having an attachment, comprising: a data port (See col. 4, lines 65-67, Remarks: Watanabe teaches a mail server that is accepting data from a mail client, it is inherent that Watanabe teaches a data port); and a processor, arranged to receive a designation of a first set of one or more recipients and a designation of a second set of one or more recipients, to actuate the data port to send the e-mail message and the attachment to the first set of one or more recipients, and to actuate the data port to send the e-mail message without the attachment to the second set of one or more recipients (See col. 5, lines 65-67 and col. 6, lines 1-12).

b. As per claim 9, Watanabe teaches wherein the processor is arranged to extract respective addresses of the one or more recipients in the first set from a field of the e-mail message indicative of primary recipients, and wherein the processor is arranged to extract respective addresses of the one or more recipients in the second set from a field of the e-mail message indicative of secondary recipients (See col. 5, lines 1-12)

c. As per claim 10, Watanabe teaches wherein the processor is arranged to actuate the display to display a list of all recipients of the e-mail message, and wherein the processor is arranged to receive from a sender of the e-mail message respective designations with respect to at least some of the displayed recipients, which differentiate between those recipients who are to be placed in the first set and those recipients who are to be placed in the second set (See col. 4, lines 54-63).

Art Unit: 2141

d. As per claim 11, Watanabe teaches wherein the processor is arranged to actuate the display to display a first visual representation, indicating that the one or more recipients in the first set were sent the e-mail message and the attachment, and wherein the processor is arranged to actuate the display to display a second visual representation, different from the first representation, indicating that the one or more recipients in the second set were sent the e-mail message without the attachment (See col. 9, lines 35-51 and figures 4 a-c).

e. As per claim 12, Watanabe teaches wherein the processor is arranged to actuate the data port to send to the second set of one or more recipients information identifying the attachment (See col. 2, lines 17-23).

f. As per claim 13, Watanabe teaches wherein the processor is arranged to actuate the data port to send to the second set of one or more recipients respective identifiers of the one or more recipients in the first set (See col. 2, lines 17-23).

g. As per claim 21 and 23, Watanabe teaches receiving as input from a sender the e-mail message and the attachment for transmission to a recipient (See col. 4, lines 65-67); receiving as input from the sender an instruction indicative of whether to save the attachment (See col. 3, lines 58-62); sending the e-mail message and the attachment to the recipient; and responsive to the instruction indicating not to save the attachment, saving the e-mail message without the attachment (See col. 3, lines 1-13).

Art Unit: 2141

h. As per claim 22, Watanabe teaches processing an electronic mail (e-mail) message having an attachment, comprising: a data port (See col. 4, lines 65-67, Remarks: Watanabe teaches a mail server that is accepting data from a mail client, it is inherent that Watanabe teaches a data port); a memory (See col. 7, lines 16-17); and a processor, arranged to receive from a sender an instruction indicative of whether to save the attachment, arranged to actuate the data port to send the e-mail message and the attachment to a recipient, and arranged to save the e-mail message in the memory without the attachment responsive to the instruction indicating not to save the attachment (See col. 15, lines 1-34).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-7 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent application No. 6,628,306 to Marchionda in view of U.S. 6,327, 612 to Watanabe.

a. As per claims 5 and 18, Marchionda the claimed invention as described above. However, Marchionda fails to teach wherein sending to the second set of one or more recipients information identifying the attachment.

Watanabe teaches sending to the second set of one or more recipients information identifying the attachment (See col. 3, lines 15-37)

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate sending to the second set of one or more recipients information identifying the attachment as taught by Watanabe in the claimed invention of Marchionda in order to indicate that attachment files have been attached to the e-mails destined to the primary recipient (See col. 3, lines 30-33).

b. As per claims 6 and 19, Marchionda teaches the claimed invention as described above. However, Marchionda fails to teach sending to the second set of one or more recipients respective identifiers of the one or more recipients in the first set.

Watanabe teaches sending to the second set of one or more recipients respective identifiers of the one or more recipients in the first set (See col. 2, lines 17-23).

It would have obvious to one with ordinary skill in the art at the time the invention was made to incorporate sending to the second set of one or more recipients respective identifiers of the one or more recipients in the first set as taught by Watanabe in the claimed invention of Marchionda in order to order to indicate that attachment files have been attached to the e-mails destined to the primary recipient (See col. 3, lines 30-33).

c. As per claim 7 and 20, Marchionda teaches the claimed invention as described above. However, Marchionda fails to teach wherein receiving the e-mail message and the attachment comprises receiving, as input from the sender, the e-mail message and a

Art Unit: 2141

plurality of attachments, wherein receiving the designation of the first set comprises receiving respective designations, for each recipient in the first set, of which one or more of the plurality of attachments are to be sent to that recipient and wherein sending the e-mail message and the attachment to the first set of one or more recipients comprises: sending the e-mail message to the first set of one or more recipients; and sending, to each recipient in the first set, the one or more of the plurality of attachments designated to be sent to that recipient.

Watanabe teaches wherein receiving the e-mail message and the attachment comprises receiving, as input from the sender, the e-mail message and a plurality of attachments, wherein receiving the designation of the first set comprises receiving respective designations, for each recipient in the first set, of which one or more of the plurality of attachments are to be sent to that recipient and wherein sending the e-mail message and the attachment to the first set of one or more recipients comprises: sending the e-mail message to the first set of one or more recipients; and sending, to each recipient in the first set, the one or more of the plurality of attachments designated to be sent to that recipient (See col. 3, lines 15-25)

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein receiving the e-mail message and the attachment comprises receiving, as input from the sender, the e-mail message and a plurality of attachments, wherein receiving the designation of the first set comprises receiving respective designations, for each recipient in the first set, of which one or more of the plurality of attachments are to be sent to that recipient and wherein sending the e-mail message and the attachment to the first set of one or more recipients comprises:

Art Unit: 2141

sending the e-mail message to the first set of one or more recipients; and sending, to each recipient in the first set, the one or more of the plurality of attachments designated to be sent to that recipient as taught by Watanabe in the claimed invention of Marchionda in order to transmit each e-mail to the respective recipients via a communication circuit (See col. 4, lines 51-53).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,256,672 to Redpath teaches a method and system for efficiently notifying an information copy recipient in an electronic mail system.'

U.S. path No. 5,903,723 to Beck et al teaches a method and apparatus for transmitting electronic mail attachments with attachment references.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M Bayard whose telephone number is (703) 305-6606. The examiner can normally be reached on 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2141

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard

July 15, 2004


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER